

### **REMARKS/ARGUMENTS**

Applicant files this Preliminary Amendment to respond to issues raised in the Final Office Action dated June 3, 2008, in which the Examiner maintains his rejection of claims 1, 3-14 and 16-23. As a preliminary matter, the Applicant wishes to thank the Examiner for considering the arguments filed on April 9, 2008. The Applicant acknowledges that claims 1, 3-14 and 16-23 are currently pending, and that claim 16 is rejected under 25 U.S.C. § 112, second paragraph, as being indefinite. Claim 16, which previously depended from canceled claim 15, has been amended to depend from pending claim 9. No new matter is added. Applicant believes the amendment to claim 16 sufficiently overcomes this rejection.

The Examiner has objected to the amended drawings as including new matter not supported by the specification. This is addressed below.

Claims 1, 3-14 and 16-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,142,337 (“Holcomb”), U.S. Pat. No. 5,727,264 (“Craig”), and U.S. Pat. No. 4,090,266 (“Price”). This rejection is also addressed below.

#### **A. Drawing Objections**

The Examiner has objected to the proposed drawing correction filed on April 9, 2008 as containing new matter not described in the original specification, specifically, elements 325 and 330. Applicant respectfully submits that elements 325 and 330 do not refer to new matter, but rather are reference characters for the operation controls already described in the originally-filed specification on page 15, line 1. Additionally, Applicant respectfully refers to the response filed on August 31, 2006, which disclose operating controls 325 and basic plumbing controls 330 in the amended paragraph beginning on page 15, line 1 of the originally-filed specification (par.

[0036] of U.S. Pat. Pub. No. 20050198731). As such, amended Figure 3 does not contain new matter, and this objection should be withdrawn.

The Examiner has also maintained his objection to Figure 3 as missing a legend and that the material cross-hatching is inaccurate in Figure 4B. Applicant respectfully submits that Figures 3 and 4B are sufficiently described in the specification (see pars. [0033]-[0036]), thereby obviating the need for further explanation under Rule 84.

## **B. Claim Rejections**

### **1. 35 U.S.C. § 103(a): The Combined Teachings of Holcomb, Craig and Price Do Not Render Claims 1, 3-14 and 16-23 Obvious.**

The Patent Examiner rejected claims 1, 3-14 and 16-23 under 35 U.S.C. § 103(a) as being unpatentable over Holcomb, Craig and Price. As stated by the Examiner, Holcomb “discloses a spa assembly comprising: a shell including a tub portion 12 and a flange 13; and plumbing elements including a suction 19 and a return 18.” Craig “discloses an analogous spa assembly which further includes a shell 18 having a spillway 50.” Examiner contends that “it would have been obvious to one of ordinary skill in the art to associate a spillway with the Holcomb shell in order to enable installation adjacent to a swimming pool.” Further, “it would have been obvious to one of ordinary skill in the spa assembly art to associate operating controls with the Holcomb spa assembly in order to facilitate operation.” Finally, in light of Price, the Examiner has rejected claims 2, 3, 15, 16, 22, and 23, stating that “Price teaches one how to install appearance-enhancing tiles on a swimming pool sidewall.” Applicant respectfully disagrees.

Applicant reiterates that notwithstanding the titles of the cited prior art references, one skilled in the art would not have perceived any benefit in combining the teachings of Holcomb, Craig and Price because the three disclosures describe three different systems for three different

purposes. Additionally, even if one were to combine the teachings of the three cited prior art references, the resulting product would still fall short of Applicant's invention. As a preliminary matter, however, the Examiner assumes that "a spa is mostly just a smaller version of a swimming pool." This broadly mischaracterizes the purpose of these two systems. A spa, or hot tub, is often used for resting, relaxing and warming the swimmer, whereas a swimming pool invites exercise and active recreation. Indeed, the purpose of Applicant's invention is to provide swimming pool owners the added benefit of an adjacent spa or hot tub in instances where a pool has already been, or is to be, constructed. The added plumbing, tiling and fixture properties of such a spa addition differentiate one system from the other, such that a spa and a pool are readily distinguishable. Applicant has highlighted this distinction with the amendments to claims 1, 9 and 22 previously presented in the April 9, 2008 response.

Holcomb describes a spa assembly where the shell of the spa is situated so that the spa lip rests on stakes (Holcomb col. 1, line 64), such that the upper lip of the Holcomb spa "is substantially flush with the ground surface grade 15 or level" (col. 2, lines 67-68). Craig discloses a pool/spa system formed by a "continuous, totally homogenous concrete bond," where "[t]he spa utilizes the plumbing . . . facilities of the swimming pool." (Craig, col. 2, line 35-36, col. 4, lines 9-10). Price provides a swimming pool construction method, wherein panel members are used to form the walls of the pool. (Price, col. 1, line 58 – col. 2, line 16). If one were to combine the stand-alone spa assembly in Holcomb (Holcomb col. 3, line 55 – col. 4, line 20), with the X-brace concrete support system from Craig (Fig. 6) and the wall assembly from Price (col. 1, line 50 – col. 2, line 16), the resulting structure would not be the integrated spa having the unique spillway, raised flat upper lip, gunite spa cavity and in-shell plumbing elements disclosed in Applicant's previously amended claims 1, 9, 22 and the rest of Applicant's

application. As such, the cited prior art does not support a Section 103(a) rejection, and claims 1, 3-14 and 16-23 should be allowed.

**C. Conclusion**

In light of the arguments above, Applicant requests that the objections to the drawings and the rejection of the claims be withdrawn, and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
DERGOSITS & NOAH LLP

Dated: 12/3/2008

By: /s/ Michael E. Dergosits  
Michael E. Dergosits  
Registration No. 31,243

Please direct correspondence to:

Michael Dergosits  
DERGOSITS & NOAH LLP  
Four Embarcadero Center, Suite 1450  
San Francisco, California 94111  
(415) 705-6377 Telephone  
(415) 705-6383 Facsimile